

Smith discloses a method for maintaining the integrity of URL references to resources embedded within web sites. The resource is static data (e.g., web pages, documents, etc.), and not usage information. Smith addresses the problems associated with changes in the location of the resources by dealing with broken hyperlinks to the resources that have been moved. When a server receives a message from a client requesting a resource via its URL reference, the server looks up the location of the resource in an indirection table and forwards a copy of the resource to the client. The indirection table contains entries that map a URL to each resource, as documents are moved or deleted, their indirection table entries must be updated. (Smith, column 11, lines 48-63.)

Independent claims 7, 14 and 15 each recite “transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network.” Independent claim 21 recites similar subject matter. The claimed subject matter transmits to the user the usage data “**when the user is connected to any other website.**” In contrast, Hoyer discloses a client side component 210 that is coupled to a server side component 225 via the Internet, where the performance measurements being sent to the client side component are **for the web site to which the client is connected.** Similarly, Smith discloses a server that forwards a copy of a resource to the client while the client is connected to the **web site in which the resource is embedded.** Applicants submit that the combination of Hoyer and Smith neither discloses nor suggests transmitting usage data to the user while “connected to any other website,” nor does the combination disclose or suggest “a monitor window” as recited in the present claims.

Further, Applicants submit that the combination of Hoyer and Smith does not result in the invention of the present claims. Hoyer and Smith results in a system and method that transmits performance measurements to a client connected to the web site being measured, and will also forward static resources (e.g., web pages and documents) in response to the client activating hyperlinks embedded in the web site, where the combination tracks changes to the location of the resources identified by the hyperlinks in an indirection table. The combination of Hoyer and Smith does not result in a method that transmits “data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network.”

Thus, the combination of Hoyer and Smith does not result in the invention of independent claims 7, 14, 15 and 21.

Additionally in considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, “[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” (emphasis added). *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant's disclosure” *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

As demonstrated above, there is no suggestion in Hoyer or Smith to combine these references. Instead, the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee’s claimed invention from prior art by using the patentee’s claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, citing *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Based on the foregoing discussion, Applicants have demonstrated that Hoyer and Smith neither discloses nor suggests, singly or in combination, the invention of independent claims 7, 14, 15 and 21. Therefore, the Examiner has not met the burden of establishing a *prima facie* case of obviousness. Claims 8-11 and 20 depend from independent claim 7. Claims 22-26 depend from independent claim 21. Applicants submit that claims 8-11, 20 and 22-26 are patentable over the combination of Hoyer and Smith for at least the same reasons as their respective base claims. Withdrawal and reconsideration of the rejection is requested.

